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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/854,311	05/10/2001	Joseph Neev	101499.0001US1	7823
34284	7590	08/11/2006	EXAMINER	
ROBERT D. FISH RUTAN & TUCKER LLP 611 ANTON BLVD 14TH FLOOR COSTA MESA, CA 92626-1931			SHAY, DAVID M	
		ART UNIT	PAPER NUMBER	3735

DATE MAILED: 08/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

SIP

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/854,311	NEEV	
	<b>Examiner</b>	<b>Art Unit</b>	
	david shay	3735	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on May 19, 2006.
- 2a) This action is **FINAL**.                  2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 21-23,25,28,29,31,33-35,37-43 and 45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 21-23,25,28,29,31,33-35,37-43 and 45 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

Applicant has filed a substitute specification as a result of the examiner's objection to the originally filed specification. This specification has not been entered and the objection to the specification stands, as request for entry of the substitute specification has no statement that no new matter has been added and as such, is not in compliance with 37 CFR 1.125(b).

The disclosure is objected to because of the form of the specification for example that portion spanning pages 76-105. Beginning with the section labeled ADDITIONAL EMBODIMENTS on page 76 there are numbered paragraphs which appear to be in the form of claims, and refer back to prior paragraph numbers with the referent "claim" but do not appear to be intended to be claims as they are in the section preceding the legend "What is claimed is" and some (e.g. 141) are not in single sentence form and make reference to drawing figures. Further the section labeled "I claim" does not have the recitations therein commencing on a separate page. Applicant should extensively amend the disclosure to put it in proper form.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The amendment May 19, 2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "the absorbing material absorbs the energy, and transfers at least a portion of the absorbed energy to the skin without ablating the skin".

Applicant is required to cancel the new matter in the reply to this Office Action.

Claims 21-23, 25, 28, 29, 31, 33-35, 37-43, and 45 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains

subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The originally filed disclosure is silent on “the absorbing material absorbs the energy, and transfers at least a portion of the absorbed energy to the skin without ablating the skin” and “generating an energy source that provides energy”

Claims 21-23, 25, 28, 29, 31, 33-35, 37-43, and 45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 21, the recitation “an intermediate substance contacting the skin” specifically recites the skin as part of the device, and as such claims the body, thus this claim is indefinite. Claim 38 is indefinite in that it is unclear exactly what the term “generating an energy source that provides energy” is intended to convey. For the purposes of applying art, this term will be construed as requiring the step of “providing energy with an energy source”. In claim 40 “the burst of electromagnetic energy” lacks positive antecedent basis.

Claims 21-23, 29, 31, 33, 34, 37-43, and 45 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Waldman et al ('346).

See Figures 6-14 and column 3, lines 5 to 41 and column 5, line 10, to column 9, line 33.

Claims 25 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Waldman et al ('346). Waldman et al ('346) teaches a method as claimed except the particular intermediate substance. It would have been obvious to the artisan of ordinary skill to employ the various intermediate materials such as agar and tracing paper, since these are equivalents to the liquids and solids of Waldman et al ('346) as they can all conform to the tissue surface and retain

an absorbing substance; are not critical; and provide no unexpected result, thus producing a device and method such as claimed.

Applicant's arguments with respect to claim s 21-23, 25, 28, 29, 31, 33-35, 37-43, and 45 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to david shay whose telephone number is (571) 272-4773. The examiner can normally be reached on Tuesday through Friday from 6:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor, II, can be reached on Monday, Tuesday, Wednesday, Thursday, and Friday. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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GROUP 330